

REMARKS

I. INTRODUCTION:

The Applicant thanks the Examiner for the careful consideration of this application. Claims 1, 5-9, 13 and 15-21 are currently amended in lieu of the Examiner's comments on pages 14 and 15 and to expedite prosecution. In view of the foregoing amendments and the following remarks, the Applicant respectfully requests the reconsideration of this Final Rejection.

II. CLAIM REJECTIONS UNDER 35 U.S.C. §103(A):

(I) On page 2, the Office Action rejects claims 1-7, 9-11, 13 and 19-21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pre-Grant Publication No. 2003/0233242 to Wenger in view of U.S. Patent No. 6,606,480 to L'Allier. Based on the foregoing amendments and the following remarks, the Applicant respectfully requests reconsideration and withdrawal of the present rejection.

a. Applicant's Removal of Intended Use Language:

The Office Action states, on page 14, that:

what specific purpose the user entry module is used for represents the intended use of the system and not the system itself. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 1647 (1987). In the instant case, whether the user entry module is used for selecting a desired certification authority or for selecting a training regimen does not matter.

In order to remove such "intended use" language, the Applicant has amended claim 1 to recite, in relevant portion: "a user information entry module *configured to present* a first user

interface to the at least one user seeking certification, wherein the first user interface is *configured to create* a user account over a network and *is further configured to allow* the at least one user to select a desired certification authority and enter user information relating to the certification by the desired certification authority ... and a planning module executed at one or more workstations and *configured to generate* one or more certification goals based on user entered information and the one or more certification requirements in the at least one authority profile, wherein the planning module *is configured to present* a second user interface to the at least one user seeking certification to select one or more presented certification goals, and wherein the planning module *is further configured to respond* to at least one user selection of the one or more presented certification goals to create a certification plan associated with the user account.”

It is well known in practice before the USPTO that the use of “configured to” language in a claim denotes a structural aspect of the claimed invention, not an intended use function. As noted in MPEP §2173.05(g), functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). A functional limitation must be evaluated and considered, just like any other limitation of the claim - for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. *See*, for example, *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) wherein the Court held that in a claim directed to a kit of component parts capable of being assembled, limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably

positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.

The Applicant respectfully submits that the amendment of claim 1 to recite, for example, a "user information entry module *configured to present* a first user interface to the at least one user seeking certification" and a "planning module ... *configured to generate* one or more certification goals," now defines the structural attributes of the user information entry module and the planning module of claim 1, similar to the claims in *In re Venezia*. The Applicant respectfully submits that these claim amendments do not require any new search on the part of the Examiner.

b. Applicant's Response to Arguments Presented in the Final Action.

These Remarks are written in view of the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) and the recently published *USPTO Examination Guidelines Update: Developments in the Obviousness Inquiry After KSR v. Teleflex*, 1358 O.G. 372 (September 28, 2010), hereinafter referred to as the "KSR Guidelines," which according to the Federal Register became effective September 1, 2010, after mailing of the Final Action. Based on the foregoing, it is respectfully submitted that the Final Action has not established a prima facie case of obviousness for the rejection of claims 1-7, 9-11, 13 and 19-21 as being unpatentable over a combination of Wenger and L'Allier. Specifically, the Final Action fails to meet the *Graham* factors in support of an obviousness rejection, as re-emphasized in the *KSR* decision. See *MPEP* §2141. The Final Action does not 1) correctly determine the scope and content of the prior art, 2) properly ascertain the differences between the claimed invention and the prior art of record and, thus, do not 3) articulate a rational underpinning to support the legal conclusion of obviousness.

According to *KSR*, the analysis supporting a rejection under 35 U.S.C. §103 should be made explicit. *See* MPEP § 2143. The Federal Circuit has stated that "*rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). *See also KSR*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). As stated in MPEP §2142, the key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reasons why the claimed invention would have been obvious. *See KSR Guidelines* at 381. The scope of the claimed invention must first be clearly determined by giving the claims the "broadest reasonable interpretation consistent with the specification." *See* MPEP §2141; *Phillips v. AWH Corp.*, 415 F. 3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005).

Office personnel fulfill the critical role of fact-finder when resolving *Graham* inquiries. *See* MPEP §2141. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. *Id.* According to the *KSR Guidelines*, when setting forth an obviousness rejection, Office personnel are to continue to make appropriate findings of fact as explained in MPEP §§ 2141 and 2143, and must provide a reasoned explanation as to why the invention as claimed would have been obvious to a person of ordinary skill in the art at the time of the invention. *Id.* at 375. This requirement for explanation remains even in situations in which Office personnel may properly rely on intangible realities such as common sense and ordinary ingenuity. *Id.* Factual findings made by Office personnel are the necessary underpinnings to establish obviousness. *See* MPEP §2141.

The Applicant respectfully submits that the Final Rejection fails to meet the fact finding burden under the *Graham* inquiry, as it fails to correctly determine the scope and content of the prior art. As a result, the determination of differences between the claimed invention and prior art is erroneous, leading to an erroneous resolution of level of ordinary skill in the art under *Graham*. Indeed, the USPTO's erroneous fact finding in this case has resulted in a flawed articulated reasoning and irrational conclusion of obviousness. "Clearly setting forth findings of fact and the rationale to support a rejection in an Office Action leads to the prompt resolution of issues pertinent to patentability." See MPEP §2141. Unfortunately, the findings of fact and the rationale to support the Final Action's obviousness rejection of the claimed invention have not been presented.

The Office Action correctly admits on page 4 that "Wegner fails to disclose wherein the planning module responds to the at least one user's selection of one or more certification goals to create a certification plan." Instead, the Office Action asserts that L'Allier teaches "a planner responsive to user selection of one or more of the generated training goals." For at least the following reasons, the Applicant asserts that the rationale of the Final Action is not supported by proper fact finding and, consequently, the Final Action has failed to resolve the ordinary skill in the art using an express and reasonable rationale.

According to proper fact finding, L'Allier teaches a system used by a supervisor or manager of an organization to identify a skill and skill level to be possessed by an end user 404. See *Column 6, Lines 6-20*. In fact, it is the supervisor or manager that identifies the end user's skills, not the end user who is seeking certification him/herself. The system of L'Allier "then accesses the skills database 402 and retrieves the user's skills and skill levels 403. If the desired skill is not already

possessed by the user 404, the desired skill is mapped with the appropriate training regimen 406. If the desired skill is already possessed by the user 404, the system then checks whether the desired skill level is less than or equal to the user's skill level 405. If so, the system exits 408. If the desired skill level is greater than that possessed by the user 405, the desired skill is then mapped with the appropriate training regimen 406; that is, the skills domain is mapped to the training domain." *See Column 6, Lines 6-20.* Simply stated, the organization, i.e. a manager and/or supervisor (not a user who is seeking certification), in L'Allier identifies a skill and skill level to be possessed by a user and the computer system of L'Allier then automatically evaluates various training options and selects an appropriate training regimen 406, which is thereafter presented to the end user 404. Proper fact finding indicates that there is nothing in L'Allier that requires a user who is seeking certification, rather than the manager or supervisor, to select desired skills via a user interface, to prepare a certification program for him/herself. Instead, L'Allier teaches a supervisor entering desired skills of a user to create a personal certification plan. Thus, the Final Action is not supported by proper fact finding and, consequently, the Final Office Action has failed to determine the differences between the prior art and the claimed invention for resolving the ordinary skill in the art using an express and reasonable rationale, as required under the Graham inquiry.

Indeed, the system of L'Allier is vastly different from the claimed invention, which requires a "planning module is configured to ***present a second user interface*** to the at least one user seeking certification ***to select one or more presented certification goals.***" The express claim language of "user seeking certification" is ignored by the Office Action, resulting in an erroneous determination of the difference between the prior art and the claimed invention under Graham. Contrary to the erroneous fact finding in the Action, the system in L'Allier neither presents certification goals to an

end user (who is seeking certification) nor allows such end user to select such certification goals him or herself. The system in L'Allier is programmed to *automatically* evaluate various training options and to *automatically* develop an appropriate training regimen for the user, without any end user selection of a certification goal. In fact, the user 404 in L'Allier is not at all involved in L'Allier's process until he or she is presented with the actual pre-selected training regimen. Since the user 404 of L'Allier plays no role in the training regimen selection process, it follows that L'Allier fails to teach the claimed requirement for presenting "a second user interface *to the at least one user seeking certification* to select one or more presented certification goals." In summary, the Action's fact finding for L'Allier is erroneous because L'Allier does not teach 1) a system that supports active use by an end user who is seeking certification him/herself or 2) a planning module that presents a second user interface to such end user to select one or more presented certification goals, as claimed.

According to the Office Action's fact finding, claim 10 of L'Allier recites "creating a user interface adapted to receive a selection of a skill desired to be learned by a user, the skill an element of the first table" and "creating a means for presenting the user with the accessed training regimen." However, according to the broadest reasonable interpretation of L'Allier, the "selection of a skill to be desired to be learned by a user" is made by a supervisor or manager of a corporation in L'Allier, not by an end user who is seeking certification. *See L'Allier*, Column 6, lines 6-20, The computer system in L'Allier then automatically takes this employer-mandated skill selection, evaluates the various training options and develops a training regimen. The end user in L'Allier is merely presented with the selected skill and the accessed training regimen. The end user in L'Allier is a

passive recipient of the entire process, not an active decision-maker, as is disclosed in the present invention. This is yet another example of the incorrect fact finding presented in the Final Action.

On page 6 and 7 of the Office Action, the “Examiner considers who, specifically, the user is to be nonfunctional descriptive material. The specific identity and/or role of the user does not change the function of the claimed invention. Examiner asserts the invention would perform the same way regardless of whom, specifically, the user is.” Based on the foregoing amendments, which remove all prior “intended use” language, the Applicant respectfully asserts that the structure of the present invention is determined by the use of the system by one who seeks certification for him/herself. For example, as noted above, L’Allier does not disclose presenting “a second user interface to the at least one user seeking certification to select one or more presented certification goals,” as recited in claim 1. This is because the end user in L’Allier plays no role in developing the training regimen. Thus, presenting a user interface to select certification goals in L’Allier is not necessary. Therefore, as currently amended, it is clear that the limitation on *who* uses the system, *who* enters user information and *who* selects the one or more presented certification goals does, in fact, determine the structure of the system.

In conclusion, Wagner in view of L’Allier does not disclose that a “planning module is configured to present a second user interface to the at least one user seeking certification to select one or more presented certification goals,” as recited in claim 1. Claims 2-7, 9-11, 13 and 19-21 depend from independent claim 1 and are patentable for at least the same foregoing reasons. Therefore, the Applicant respectfully requests that the Examiner reconsider and withdraw the present rejection.

(2) On page 9, the Office Action rejects claims 8, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over Wenger in view of L'Allier and in further view of U.S. Pre-Grant Publication No. 2003/0046256 to Orton et al. Claims 8, 15 and 16 depend from independent claim 1 and are patentable for at least the same foregoing reasons. Orton does not remedy the deficiencies of Wenger and L'Allier. The Applicant respectfully requests the reconsideration and withdrawal of the present rejection.

(3) On page 11, the Office Action rejects claims 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over Wenger in view of L'Allier and in further view of Finaid.org (2002). Claims 17 and 18 depend from independent claim 1 and are patentable for at least the same foregoing reasons. Finaid.org does not remedy the deficiencies of Wenger and L'Allier. The Applicant respectfully requests the reconsideration and withdrawal of the present rejection.

(4) On page 12, the Office Action rejects claim 12 under 35 U.S.C. §103(a) as being unpatentable over Wenger in view of L'Allier and in further view of the Examiner's Official Notice. Claim 12 depends from independent claim 1 and is patentable for at least the same foregoing reasons. The Examiner's Official Notice does not remedy the deficiencies of Wenger and L'Allier. The Applicant respectfully requests the reconsideration and withdrawal of the present rejection.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. The Applicant, therefore, respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. The Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided. Prompt and favorable consideration of this Amendment is respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 22-0261, under Order No. 29239-190105.

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Respectfully submitted,

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